

REMARKS

This response is filed in reply to the Office Action mailed December 15, 2003.

Following entry of the present amendment, the status of the claims will be as follows:

Claims 6-9, 12, 15, 16, 18, 19, 28-30, 34, 36-39 and 42 are canceled;

Claims 1, 3, 13, 17, 23, 26, 27, 31, 32, 33, 40 and 41 are currently amended;

Claims 20, 21, 22 and 35 are allowable; and

Claims 2, 4, 5, 10, 11, 14, 24 and 25 are reiterated.

No new matter has been added. Claims 1-5, 10, 11, 13, 14, 17, 20-27, 31-33, 35, 40, 41 and 43 are pending and at issue. Applicant requests reconsideration of the present application.

Objections

The disclosure is objected to because it contains an embedded hyperlink. The paragraph containing the hyperlink has been amended to obviate the objection. Applicant requests withdrawal of the objection.

I. Rejections under 35 U.S.C. §112, First Paragraph

Written Description

Claims 1, 2, 3, 4, 5, 6, 7, 8, 10, 11, 13, 14, 26 and 27 stand rejected under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to enable one skilled in the relevant art to make or use the invention. This rejection is moot with regard to canceled claims 6, 7 and 8. Applicant traverses this rejection as it may apply to the amended claims.

Specifically, the Office Action alleges that the specification lacks sufficient guidance as to the administration of the 52/55 kDa protein to a cell. Claims 1 and 27 have been amended to recite, in part, an adenovirus replication competent host cell comprising a "nucleic acid sequence encoding" an adenovirus 52/55 kDa trans-acting protein. Additional claims have been amended solely to clarify the mechanism by which the protein is expressed in such cells. Accordingly, Applicant requests that the rejection under §112, first paragraph, be withdrawn.

II. Rejections Under 35 U.S.C. §112, Second Paragraph

Claims 1, 2, 3, 4, 5, 6, 7, 8, 10, 11, 12, 14, 15, 18, 19, 23, 24, 25, 26, 27, 31, 32, 33, 34, 40, 41 and 42 stand rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. This rejection is moot with regard to canceled claims 6-9, 12, 15, 18, 19, 34 and 42. Applicant traverses this rejection as it may apply to the amended claims.

Specifically, claims 3 and 23 have been amended to clarify that the first serotype-specific cis-acting packaging sequence is from a different serotype than the second adenovirus serotype-specific cis-acting packaging sequence.

In addition, claim 23 has been amended to recite a “second adenovirus serotype-specific sequence” as suggested by the Examiner. Similarly, claims 31, 32 and 33 have been amended to recite the “first adenovirus sequence” as suggested by the Examiner.

Finally, the claims have been amended to clarify that the second adenovirus nucleic acid sequence comprises those sequences necessary to complement the production and/or packaging of the first adenovirus nucleic acid sequence.

In view of the amendments to the claims, Applicant requests that the rejections under 35 U.S.C. §112, second paragraph, be withdrawn.

III. Provisional Nonstatutory Double Patenting Rejection

Claims 17, 19 and 42 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 9 and 10 of co pending Application No. 10/135,895 ('895). This rejection is moot with regard to canceled claims 19 and 42. While Applicant respectfully traverses this rejection, Applicant notes that claim 17 has been amended. Applicant submits that the amended claim is patentably distinct from claims 9 and 10 of the co-pending '895 application and requests withdrawal of the provisional rejection.

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In summary, for the reasons set forth herein, Applicant maintains that claims 1-5, 10, 11, 13, 14, 17, 20-27, 31-33, 35, 40, 41 and 43 clearly and patentably define the invention.

Applicant respectfully requests that the Examiner reconsider the various grounds set forth in the Office Action, and allow all the claims that are now pending.

If the Examiner would like to discuss any of the issues raised in this response, Applicant's representative can be reached at (858) 678-5070. Applicant asks that all claims be allowed. Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

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